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09/557,617	04/25/2000	Thomas G. Woolston	11092-005002	9094

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EXAMINER

SNAPP, SANDRA S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 08/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,617

Applicant(s)

WOOLSTON, THOMAS G.

Examiner

Sandra Snapp

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

The application contains claims directed to the following patentably distinct species of the claimed invention:

Group I: claims 11-18

Group II: claims 19-21

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the

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prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that a reply to this requirement, to be complete, must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Information Disclosure Statement

The information disclosure statement filed has only partially been considered as reflected on the attached copy. The Applicant indicated copies of the references were submitted in appl. Serial no. 08/166,779, however a review of that application did not produce the references. The Examiner has pulled all the US applications and reviewed those applications, however she cannot access the printed publications. It is therefore the Applicant re-submit copies of the printed publications and foreign references for consideration in this application.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed features of claims 19-21 (i.e. the system that pays interest from investments in US treasury notes, etc.) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

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The disclosure is objected to because of the following informalities:

- 1) reference number for the tape drive "24" shown in Fig. 1 is not in the specification (see spec on page 4, lines 20+);
- 2) On page 11, line 26, should the term "specially" should be - -specialty- -?
- 3) On page 13, line 1, the phrase "good that matches" should be - -goods that match- -;
- 4) Figure 1 is a schematic view and should be identified as such in the figure description on page 14, line 5;
- 5) On page 19, line 6, the term "bids" should be - -bid- -.
- 6) On page 19, line 22, the term "implement" should be - -implemented- -.
- 7) On page 28, line 11, the spec. states "market designator field 954" yet on page 29, line 3, the spec states "market field 952" and on line 4, "selection bar 954" the inconsistency should be corrected. It appears from Fig. 13, that 952 is indeed the market designator field and that 954 is the selection bar.

The continuing data information submitted in the preliminary amendment is inconsistent with the Patent Office records. The PTO shows 09/166,779 as being a continuation application of 08/554,704, and 08/554,704 as being a continuation-in-part of 08/427,820. A portion of the amended information appears to be redundant with lines 4-6 on page 1 of the specification after the heading "Background of the Invention." Also, the information should be updated to reflect any issued patents or abandoned applications. Correction of the information under the section entitled "Cross-Reference to Related Applications" should reflect the correct history of the application.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The “data packet communication network”, “data packet protocol”, and “data packet network participants” in the independent claims were not described in the specification.

In claim 14, the limitation of a “hypertext transport protocol in a predetermined presentation format” is not identified and explained in the specification.

Claims 13, 16-18, and 20-21 all depend from rejected base claims 12, 15 and 19.

Claims 19-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not clearly disclose a system that returns interest on positive balances, means for deducting from the accounts in response to accepted offers, means for receiving offers from data packet network participants and means for associating the offers from the participants with the account information as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 is indefinite because in the preamble the term “transactions” (plural) is used, yet on line 10, the term “transaction” (singular) is used. Such inconsistency is confusing. On line 7, the term “users” is used when previously in line 2, “participants” is used. Are these the same or different?

In claims 11, 12, and 15, the term “participant” (singular) and the term “participants” (plural) are both used, yet there is no indication the singular participant is a member of the participants group, or a different participant altogether. Clarification is required.

In claim 12, line 5, “payment information” is introduced, yet on line 11 “payment information” is not preceded by “said” or “the”, is this different information or the same?

In claim 12, line 11, the phrase “said transaction” lacks antecedent basis.

In claim 15, the phrase “a predetermined participant” is confusing because it is unclear if such a participant is different than the previously discussed participants or a new, different participant.

In claim 16, the term “offer” is inconsistent with the “offers” of claim 15.

In claim 19, lines 5 & 7, and claim 20, line 1, the phrase “said accounts” lacks antecedent basis.

In claim 20, is the “paid” interest referring to the interest ‘returned’ via the “means for returning” in claim 19, or is it different?

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Consistent terminology should be used throughout the claims.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-18, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by the Wiseman patent (US 5,168,446).

The Wiseman patent discloses a system for facilitating electronic commerce transactions comprising a means for interfacing a plurality of participants from a data packet communications network (network of trading stations, col. 2, lines 25-29); a means for verifying participant identification information (structured data packets, col. 2 lines 61-69 and col. 3, lines 1-5); a means for detecting participant user interface programs (structured data packets, col. 2 lines 61-69 and col. 3, lines 1-5); means for providing access to a new user interface program to the plurality of users (structured data packets, col. 2 lines 61-69 and col. 3, lines 1-5); a means for receiving an offer from a first participant (col. 3, lines 5-23); means for receiving acceptance of an offer from a second participant (col. 3, lines 23-55); means for processing and storing payment information associated with the transaction (col. 4, lines 31-32); means for notifying a participant that an offer has been accepted (col. 4, lines 19-27); and means for tracking account information (col. 4, lines 36-47).

Allowable Subject Matter

Claims 19-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraphs, set forth in this Office action.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Kramer, Walker et al., Brown, and Woolston patents all disclose online auction systems. The Rosen reference is directed to a foreign exchange transaction system online, and the King, Jr. et al. discloses a "System For Ordering Items Using An Electronic Catalogue."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

ss *h*
August 11, 2002


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